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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/681,110      | 10/09/2003  | Qamar Abbasi         | Q77922              | 8078             |

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3202

EXAMINER

ODLAND, KATHRYN P


ART UNIT PAPER NUMBER

3743

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*Elo*

|                              |                               |  |  |
|------------------------------|-------------------------------|--|--|
| <b>Office Action Summary</b> | Application No.<br>10/681,110 | Applicant(s)<br>ABBASI, QAMAR  |  |
|                              | Examiner<br>Kathryn Odland    | Art Unit<br>3743   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 67-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/9/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 67, 68, 71, 74 and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohn et al. in US Patent No. 4,709,695.

Regarding claim 67, Kohn discloses an eye shield (2, 4 and associated components) for protecting an eye of a subject. The eye shield has a patch (2/4), having a peripheral frame portion (periphery of 4/6) of opaque material defining an outer periphery. Column 4, lines 5-12 discuss opaque material. Further, given that shown and discussed with regard to figures 1 and 2, the periphery will be opaque, especially at the adhesive area. Therefore, the periphery of the covering (4/6) is interpreted as opaque. The periphery is also substantially similar in shape to the oval outline shape of an eye cavity, as seen in figures 1 and 2. There is a window (such as 26) of transparent material located within and framed by the frame portion, the window (such as 26) being located for facilitating viewing of the open/closed state of the upper and lower eyelids of the subject. The device is capable of performing the function of for facilitating viewing of the open/closed state of the upper and lower eyelids of the subject and intended use does not hold patentable weight in apparatus claims. The

frame portion (4-6) and the window (such as 26) define a front major surface and rear major surface. The rear major surface (such as @ 10) is provided for in use abutting the upper and lower eyelids of the subject. As shown in figure 1, the upper portion of the rear major surface of the frame portion defines an upper adhesive portion (@ 10 @ upper eye) that is capable of securing the patch to the upper eyelid. A lower portion of the rear major surface of the frame portion defines a lower adhesive portion (@ 10 @ lower eye) that is capable of securing the patch to the lower eyelid or to a portion of the face of the subject below the eye, so that when the upper and lower adhesive portions (@ 10) are secured to the eyelids or to the upper eyelid and a portion of the face below the lower eyelid, the eyelids are retained closed. The device is capable of performing the function and applicant is reminded that intended use and functional language do not hold patentable weight in apparatus claim. Further, the device is capable of performing the function and the intended use. The size and shape of the eye will vary. For example the size of an eye of an infant will differ from that of an adult. Further, the eye size of a human may differ dramatically from other animals. Therefore, the device will be sized according to application and eye size. The window (such as 26) defines a non-adhesive intermediate area (@ the portions of the rigid arch of 26) of the rear major surface intermediate the upper and lower adhesive portions (@10) capable of in use coinciding with the eyelashes of the upper and lower eyelids of the subject when in the closed state to prevent

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adhesion of the patch to the eyelashes for facilitating removal of the eye shield without plucking of the eyelashes, and with minimum discomfort to the subject.

Regarding claim 68, Kohn et al. disclose that as applied to claim 67 as well as a non-adhesive intermediate area that extends from one side edge to another opposite side edge of the patch between the upper and lower adhesive portions (@10) thereof, as seen in figures 1 and 2.

Regarding claim 71, Kohn et al. disclose that as applied to claim 67 as well as an upper adhesive portion (@ 10 upper) that defines an area, which is substantially similar to the shape of an upper eyelid when closed, as seen in figures 1 and 2.

Regarding claim 74, Kohn et al. disclose that as applied to claim 67 as well as a patch (2/4) that is of oval shape and defines a major axis, which in use extends substantially parallel to a line defined by the abutting edges of the upper and lower eyelids of the eye when closed, as seen in figures 1 and 2. This is dependent upon which direction from the axis is chosen as the reference.

Regarding claim 79, Kohn et al. disclose that as applied to claim 67 as well as a patch (2/4) that is of a flexible material which is substantially impermeable to chemicals and other solutions used in a surgical procedure or in the preparation

of a subject for surgical procedure, as recited in column 5, lines 55-68 and column 4, lines 5-20.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohn et al. in US Patent No. 4,709,695 in view of Goffman in US patent No. 4,862,902.

Regarding claims 69 and 70, Kohn et al. disclose that as applied to claim 67. However, Kohn et al. do not recite an adhesive tab that extends downwardly from the lower adhesive portion of the patch or a pair of adhesive tabs that diverge outwardly from each other extend downwardly from the lower adhesive portion of the patch. On the other hand, Goffman teach a pair of adhesive tabs (64) that diverge outwardly from each other extend downwardly from the lower adhesive portion of the patch, as recited in column 4. Thus, it would be obvious to one with ordinary skill in the art to provide the device of Kohn et al. with adhesive tabs that extend outwardly for the purpose of increased adhesion and ease of removal.

5. Claims 72, 78 and 81 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kohn et al. in US Patent No. 4,709,695.

Regarding claim 72, Kohn et al. disclose that as applied to claim 67.

However, Kohn et al. do not recite a non-adhesive tab that extends from the patch (2/4) for facilitating removal of the patch from an eye of the subject.

However, Kohn et al. do recite a non-adhesive tab that extends from the covering portion (4) for facilitating removal. Thus, it would be obvious to one with ordinary skill in the art to provide a non-adhesive tab on the portion (2) in addition to or in the alternative to facilitate removal.

Regarding claim 78, Kohn et al. disclose that as applied to claim 67.

Further, Kohn et al. disclose release sheet (12). Thus, it would be obvious if not inherent to have a pair of protective release sheets that are provided for covering the respective adhesive portions the protective release sheets meeting adjacent the major axis of the patch and adjacent edges of the release sheets extending parallel to the major axis of the patch the respective release sheets overlapping adjacent the major axis of the patch.

Regarding 81, Kohn et al. disclose that as applied to claim 67. Further, a pair of eye shields would be obvious if not inherent.

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6. Claim 80 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kohn et al. in US Patent No. 4,709,695.

Regarding claim 80, Kohn et al. disclose that as applied to claim 67.

However, Kohn et al. do not explicitly recite a frame portion of the patch and window that are of ethylene vinyl acetate. On the other hand, Kohn et al. disclose that a variety of materials can be used. Thus, it would be obvious to one with ordinary skill in the art and within the scope of the invention to use ethylene vinyl acetate as it is a well-known material.

7. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kohn et al. in US Patent No. 4,709,695 in view of Price in US Patent No. 5,887,590.

Regarding claim 73, Kohn et al. disclose that as applied to claim 72.

However, Kohn et al. do not explicitly recite a non-adhesive tab that extends upwardly from the upper adhesive portion of the patch for facilitating removal of the patch from the eye in a direction from the upper eyelid downwardly towards the lower eyelid for minimizing discomfort to the subject during removal thereof. On the other hand, Price teaches a non-adhesive tab (11) that extends upwardly from the upper adhesive portion of the patch for facilitating removal of the patch from the eye in a direction from the upper eyelid downwardly towards the lower eyelid for minimizing discomfort to the subject during removal thereof, as recited in column 2. Thus, it would be obvious to one with ordinary skill in the art to



modify the invention to Kohn et al. to include a non-adhesive tab for the purpose of ease of removal.

8. Claims 75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohn et al. in US Patent No. 4,709,695 in view of Meshel in US Patent No. 5,191,879.

Regarding claims 75-77, Kohn et al. disclose that as applied to claim 67. However, Kohn et al. do not recite a patch that defines an upper straight edge for preventing contact of the patch with the eyebrow of the eye, and the upper straight edge of the patch extends parallel to the major axis of the patch where the window defines an upper straight edge which extends parallel to the major axis of the patch and the upper straight edge of the window lies above the major axis of the patch. On the other hand, Meshel teaches an eye patch with an upper straight edge, as seen in figure 1. Thus, it would be obvious to one with ordinary skill in the art to provide the device of Kohn et al. with an upper straight edge for preventing contact with the eyebrow. This modification would necessarily yield a window that is of semi-oval shape, extending downwardly from the upper edge thereof.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (571) 272-4801. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (571) 272-4791. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO



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